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PATENT APPLICATION

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IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Patricia S. Kruse

Confirmation No.: 2622

Application No.: 09/929,430

Examiner: M. Milia

Filing Date: August 13, 2001

Group Art Unit: 2622

Title: PRESENTATION PRINT JOB PROFILING

Mail Stop Appeal Brief - Patents  
Commissioner For Patents  
PO Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on June 12, 2006.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

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Respectfully submitted,

Patricia S. Kruse

By

Walter W. Karnstein

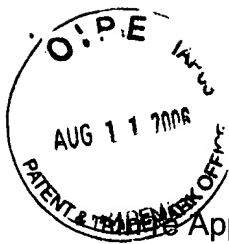
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PATRICIA S. KRUSE

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S i r:

**REPLY BRIEF OF APPELLANT**

This Reply Brief of Appellant is presented in reply to the Examiner's Answer dated June 12, 2006.

**New GROUNDS OF REJECTION**

At the time of appeal to the Board, claims 1, 4, 6-9, 12, 14, 15-17, 20, 22-25, 28, and 30-32 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,579,087 to Salgado ("Salgado"). Further, claims 2, 10, 18, and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Salgado in view of U.S. Patent No. 6,026,416 to Kanerva et al. ("Kanerva et al."). Moreover, claims 3, 5, 11, 13, 19, 21, 27, and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Salgado in view of U.S. Patent No. 5,481,353 to Hicks et al. ("Hicks et al.").

In the Appeal Brief, Appellant argued, among other things, that the cited references fail to disclose each feature of the rejected claims. For example, Appellant noted that Salgado does not disclose specifying a set of individual packaging characteristics with respect to each file added to a presentation profile. Further, Appellant asserted that the Examiner did not establish a case for *prima facie* obviousness under 35 U.S.C. § 103(a). A *prima facie* case was not established at least because there is no motivation to combine the cited references and the proposed combinations fail to disclose each feature of the rejected claims.

In the Examiner's Answer, the Examiner maintains the aforementioned rejections of the claims and now rejects claims 17-24 under 35 U.S.C. § 101. The Examiner asserts that claims 17-24 are directed to non-statutory subject matter because the claims do not recite language defining a computer-readable medium.

Appellant now respectfully maintains her traversal of the Examiner's original rejections and traverses the Examiner's new rejection of claims 17-24 under 35 U.S.C. § 101. By filing this Reply Brief of Appellant, Appellant now respectfully requests that the appeal be maintained. Arguments in support of Appellant's position with regard to the new ground for rejection are set forth below.

## **ARGUMENT**

Claims 17-24 are directed to statutory subject matter under 35 U.S.C. § 101 because they recite articles of manufacture and machines.

### **i. Standard of Review**

Statutory subject matter includes “any new and useful process, machine, manufacture, or composition of matter....” 35 U.S.C. § 101. “In choosing such expansive terms as ‘manufacture’ ... modified by the comprehensive ‘any,’ Congress plainly contemplated that the patent laws would be given wide scope.” *Diamond v. Chakrabarty*, 447 U.S. 303 (1980). The Supreme Court “has read the term ‘manufacture’ in § 101 in accordance with its dictionary definition to mean ‘the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery.’” *Id.* The term “‘machine’ includes every mechanical device or combination of mechanical powers and devices to perform some function and produce [a] certain result or effect....” *Corning v Burden*, 56 US 252 (1854).

With regard to computer-related claims, the MPEP specifies certain examination procedures. “Office personnel should determine whether [a] computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim.” § 2106 IV.B.1(a). Thus, the MPEP specifies that a statutory article of manufacture or a machine including a computer program is still statutory subject matter under § 101.

**ii. Discussion**

Claim 17 recites statutory subject matter because it is directed to both a machine and an article of manufacture. Claim 17 recites:

A computing device comprising:  
a memory comprising computer-executable instructions for automatically printing each file in a presentation profile;  
a processor that is operatively coupled to the memory, the processor being configured to fetch and execute the computer-executable instructions from the memory, the computer-executable instructions comprising instructions for:  
adding a plurality of files to a presentation profile;  
specifying a set of individual printing characteristics with respect to each of the files;  
specifying a set of individual packaging characteristics with respect to each of the files; and  
responsive to a single print request, printing a presentation package including each of the files in the presentation profile based on the individual packaging characteristics and individual printing characteristics corresponding to each of the files.

Claim 17 is not directed to a computer program, but instead recites a computing *device*. The computing device comprises structural elements, namely a memory and a processor. While the claim recites that the memory comprises certain computer-executable instructions, the claim is not directed to a computer program, but rather is directed to a device. The computer executable instructions are a part of the memory structural element which is part of the recited computing device.

A device satisfying the § 101 statutory subject matter requirement remains statutory even though it includes a computer program. § 2106 IV.B.1(a). If a “computer program is being claimed as part of an otherwise statutory manufacture or machine . . . the claim remains statutory irrespective of the fact that a computer program is included in the claim.” *Id.* Here, the claim 17 computing device is an otherwise statutory manufacture

or machine; the fact that the device includes a memory comprising computer executable instructions does not somehow make it non-statutory.

The claim 17 computing device is a statutory article of manufacture. A computing device comprising a memory and a processor is an article produced by hand or by machinery from a combination of prepared materials. *Diamond v. Chakrabarty*, 447 U.S. 303 (1980). The claim 17 computing device falls squarely within the Supreme Court's definition of "a manufacture" and Congress intended patentable subject matter to be given wide scope. *Id.* Thus, the claim 17 computing device is a statutory manufacture under 35 U.S.C. § 101.

The computing device recited in claim 17 is also a machine under 35 U.S.C. § 101. A machine is any mechanical device or combination of mechanical actions to perform some function or produce some result. *Corning v Burden*, 56 US 252 (1854). A computing device is a mechanical device or a combination of mechanical actions at least because it includes a processor. It is generally known in the art that a processor includes numerous switches that direct a flow of electricity by moving contacts with actuators between open and closed positions. Moving the contacts is a mechanical action that makes a processor a mechanical device. Expressed another way, a processor combines the mechanical actions of each actuator moving contacts into open and closed positions to perform the function of directing the flow of electricity. Thus, because the computing device includes a processor, which is a mechanical device, the computing device is a machine under 35 U.S.C. § 101.

### iii. Conclusion

The computing device recited in claim 17 fits within the Supreme Court's definitions of a manufacture and a machine. Because 35 U.S.C. § 101 expressly states that any new and useful manufacture or machine is patentable subject matter, the claim 17 computing device is statutory subject matter. Further, the MPEP indicates that a statutory manufacture or machine is not rendered non-statutory because it includes a computer program. Accordingly, the computing device recited in claim 17, which is a statutory manufacture and machine, is still statutory even though it includes computer executable instructions.

Claims 18-24 similarly recite statutory subject matter because they depend from and incorporate each of the elements of claim 17. Claims 18-24 each include the memory and the processor structural elements recited in claim 17 and, therefore, are statutory manufactures and machines for at least the same reasons as discussed for claim 17.

Respectfully submitted,

KOLISCH HARTWELL P.C.

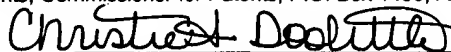


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Christie A. Doolittle